

92. (New) An apparatus as recited in claim 9, wherein said apparatus is adapted to detect specific binding reactions within said cell.

sub D₁₁ 93. (New) An apparatus as recited in claim 69, wherein said apparatus is adapted to detect specific binding reactions within said cell.

REMARKS

Claims 5-12, 33-36, and 46-68 were pending in the above-captioned application. Of the above, claims 33-36 and 63-68 are withdrawn from further consideration by the examiner, as being drawn to a non-elected invention, the requirement having been traversed. Claims 5-12 and 46-62 remain under consideration. Claims 5-11, 33-36, 46-53, 55-57, 59-63, 65, and 67 have been amended and claims 69-93 have been added to more particularly point out and distinctly claim the subject matter of the present invention.

Upon entry of the amendments, therefore, claims 5-12, 33-36, and 46-93 will be pending. A copy of the claims which will be pending upon entry of the amendments is attached as Exhibit A. A marked-up version of the changes made to the claims is attached as Exhibit B and is captioned "Version with markings to show changes made."

The amended claims and the new claims are fully supported in the specification as originally filed. The amendments do not, therefore, constitute new matter. Applicants respectively request that the amendments be entered.

The following remarks are believed to be fully responsive to the Office Action mailed December 18, 2000.

1. THE REJECTION UNDER 35 U.S.C. § 112, SECOND PARAGRAPH
SHOULD BE WITHDRAWN

Claims 5-12, and 46-62 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. In particular, the Examiner has objected to the failure to recite limitations in the claims. In response, Applicants submit that each of these rejections have been overcome and/or obviated by the amendments made herein.

First, the Examiner has rejected claims 5 and 9 for failing to recite the presence of binding reagents for carrying out the binding assays recited in the preamble of the claims. In response, claim 5 has been amended to specify the presence of “one or more binding domains”. Claim 9 has been amended to specify the presence of “binding assay reagents”.

Next, the Examiner contends claims 53 and 62 are vague as it is not clear as to what constitutes an “electromagnetic actuator”. The Examiner further contends that an “electromagnetic actuator” can be “anything from an electric motor to a magnetic stirrer”. In response, Applicants submit that the term “electromagnetic actuator” is clear when properly construed in view of specification. The claim does not read on “anything from an electric motor to a magnetic stirrer” since the term “electromagnetic actuator” is limited to devices such as speakers, crystal oscillators, pendulum devices, solenoids and the like which may be used for sonicating the contents of the cell. See page 18, lines 13-17 of the Specification. Therefore, the term is not indefinite when properly construed in view of specification. Moreover, breadth of a claim alone is not to be equated with indefiniteness. *In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971). Also see MPEP 2173.04.

For all the above reasons, Applicants respectfully submit that each of the Examiner’s rejections under 35 U.S.C. § 112, second paragraph has been overcome and/or obviated. Applicants therefore respectfully request that the rejections be withdrawn.

2. THE REJECTION UNDER 35 U.S.C. § 102(b) SHOULD BE
WITHDRAWN

Claims 5, 6, 9, 10, 12, 52, and 61 are rejected under 35 U.S.C. § 102(b) as being anticipated by Grant et al., U.S. Patent No. 5,247,954 (hereinafter "Grant"). Further, claims 5 and 9 are rejected under 35 U.S.C. § 102(b) as being anticipated by Walter, U.S. Patent No. 4,114,194 (hereinafter "Walter"). In response, Applicants submit that each of these rejections should be withdrawn for the reasons stated below.

As noted above, claims 5, 6, 9, 10, 12, 52, and 61 have been amended to more particularly point out and distinctly claim the subject matter of the invention. In particular, each claim has been amended to recite a binding domain or a binding reagent.

A finding of anticipation under 35 U.S.C. § 102 requires the disclosure in a single prior art reference of each element of the claim under consideration. *W.L. Gore & Associates v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983). There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. *Scripps Clinic & Research Found. v. Genetech Inc.*, 927 F.2d 1565, 18 USPQ 2d 1001, 1010 (Fed. Cir. 1991).

Regarding the rejection of claims 5, 6, 9, 10, 12, 52 and 61 as being anticipated by Grant, the relevant inquiry in this instance is whether Grant teaches an apparatus for use in carrying out a binding assay which includes at least one or more binding domains or binding reagents.

Grant discloses a megasonic cleaning system for use in cleaning electronic or semiconductor wafers or substrates in a wafer carrier. The system comprises a tank and a plurality of staggered piezoelectric ceramic transducers bonded to a lower surface of a tank. The

system does not disclose cells having binding domains or binding reagents. Thus, these amended claims are not anticipated by Grant.

Similarly, regarding the rejection of claims 5, and 9 as being anticipated by Walter, Walter again fails to teach every element in the amended claims 5 and 9.

Walter discloses an ultrasonic cleaner comprising a tank wherein an ultrasonic transducer is attached to a bottom portion of the tank. It also fails to disclose cells having binding domains or binding reagents. For the same reasons stated for the Grant reference, Applicants believe claims 5 and 9 not to be anticipated by Walter.

Thus, Applicants respectfully submit that each of the Examiner's rejections under 35 U.S.C. § 102(b) has been overcome and/or obviated and respectfully request that the rejections be withdrawn.

CONCLUSION

In view of the amendments and remarks herein, Applicants believe that each ground of rejection or objection made in the instant application has been successfully overcome or obviated, and that all the pending claims are in condition for allowance. Withdrawal of the Examiner's rejections and objections, and allowance of the current application are respectfully requested.

The Examiner is invited to telephone the undersigned in order to resolve any issues that might arise and to promote the efficient examination of the application.

A check in the amount of \$305.00 is submitted herewith to cover the added new claims. No additional fee is believed necessary for entry of this Amendment. However, the

Commissioner is hereby authorized to charge any additional fee to Deposit Account No. 50-0540.

Respectfully submitted,

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